REMARKS

Claims 1-27 are all the claims currently pending in the present application.

Formal Matters

The Examiner is respectfully requested to return, with the next communication, a signed and initialed copy of the PTO-Form 1449 submitted with the June 4, 2004 IDS.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shear, U.S. Patent No. 5,410,598 ("Shear"). Applicants respectfully traverse this rejection as discussed below.

Claims 1-27 over Shear

Regarding the Examiner's §103(a) rejection of Claims 1-27 over Shear, Applicants respectfully submit that Shear fails to teach or suggest each of the limitations of the present invention as set out in the claims.

Claims 1, 7, and 13. Regarding Claims 1, 7, and 13, the Examiner acknowledges that Shear fails to teach or suggest a design database, as claimed, containing information on sample circuits. (Office Action, p. 4). Further, Applicants submit that Shear fails to teach or suggest a designer terminal for a designer to search such a design database and conduct the design of a device.

Shear is directed to a system and method for controlling the use of a database, and for calculating and transmitting charges incurred for the use of the database. According to Shear, a customer is provided with a storage medium, such as a CD-ROM, on which a database is

encrypted. In order to access the information in the database, the customer's host computer is connected to a hardware device on which a decoder/billing program is stored. When the customer accesses index information within the database and selects information to be read and downloaded from the database, the selected encrypted information is received and decrypted by the decoder/billing program, and thereby made accessible to the customer. The decoder/billing program additionally measures the quantity of usage or other parameters relating to the decrypted information and stores these measurements in a memory device. Finally, the memory device is subsequently transmitted, either physically or via electronic communication connections, to a central billing facility which bills the customer for use of the database. (Col. 1, lns. 20-25; col. 5, lns. 10-56; Fig. 1).

Applicants submit that, with respect to the present invention, Shear merely discloses a database, provided on a portable memory, which can be decrypted and downloaded to a personal computer through use of a program which decrypts selected information from the database and stores a record of downloaded information in a memory. Shear fails to disclose any of the limitations of the present invention, including a database containing information on sample circuits, or any design terminal which enables a designer to search a design database and to conduct the design of a device.

The Examiner alleges that these differences between the presently claimed invention and the cited reference are incapable of distinguishing the present invention over the cited reference because they incorporate merely non-functional data under *In re Gulack*, 703 F.2d 1381, 217

USPQ 401 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ 1031 (Fed. Cir. 1994). (Office Action, p. 4).

Applicants submit that the Federal Circuit's opinions in *Gulack* and *Lowry* do not support the Examiner's position, and further that the Federal Circuit specifically supports that patentable weight is to be given to claim limitations such as the presently-claimed limitations discussed above.

In *Gulack*, the Federal Circuit held that "where printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Gulack*, at 1385. However, in its opinion in *Lowry*, the Federal Circuit first notes that in *Gulack*, the court "cautioned against a liberal use of 'printed matter rejections' under section 103." *Lowry* at 1583. Additionally, the *Lowry* court distinguishes the facts of *Gulack* from a situation involving information stored in memory, where "'the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.'" *Lowry*, at 1583. The *Lowry* court goes on to emphasize that "the printed matter cases have no factual relevance here," referring to claims, such as those of the present invention, which recite databases which store information to be utilized by computer applications. *Id.*

Therefore, Applicants respectfully request that the Examiner give patentable weight to the above-discussed limitations, which the Examiner has acknowledged are not taught in the Shear reference.

Furthermore, regarding Claims 1 and 7, Applicants submit that Shear fails to teach or suggest an account terminal, as claimed, for making a payment from a bank account of a designer. The Examiner refers to col. 3, ln. 60 to col. 4, ln. 60 of Shear as teaching this limitation. (Office Action, p. 3). However, contrary to the assertion of the Examiner, neither the cited portion, nor any other portion of Shear teaches or suggests an account terminal for making a payment form a bank account of a designer, as claimed. In contrast, the system of Shear discloses a central billing facility which receives information regarding charges to be billed to a database user and bills the user. There is no teaching or suggestion of an account terminal which makes a payment from the bank account of a user, as claimed.

Therefore, for at least the above reasons, Applicants submits that Claims 1, 7, and 13 are patentable over Shear.

Claims 2-6, 8-12, and 14-27. Applicants submit that Claims 2-6, 8-12, and 14-27 are patentable at least by virtue of their dependence on Claims 1, 7, and 13, and for the following additional reasons.

Regarding Claims 2, 8, and 14, Shear fails to teach or suggest a design database searchable on a world wide web (WWW) site, as claimed. The Examiner refers to col. 4, lns. 20-40 of Shear as teaching this limitation. (Office Action, p. 3, 4, and 6). This portion of Shear describes a database stored on a CD-ROM and provided to a customer, as discussed above, and fails to teach or suggest any design database searchable on a WWW site. Further, while Shear fails to specifically discuss any database searchable through a WWW site, Shear teaches away

from the use of remote centralized databases only accessible to a user through telephone lines or other communication means. Shear specifically discusses a number of "important disadvantages" of such databases. (Col. 2, lns. 20-43).

Regarding Claims 3, 9, 21, and 24 Shear fails to teach or suggest paying a fee from the bank account of one party to the bank account of another party, as claimed. The Examiner refers to col. 6, lns. 25-40 as teaching this limitation. (Office Action, p. 3, 5). This portion of Shear describes a system of charging for database use based on the quantity of information decrypted as preferable to a system that charges a large one-time use fee. As discussed above with respect to Claims 1 and 7 there is no teaching or suggestion in any part of Shear of an account terminal making a payment from a bank account of a designer. Likewise, Shear fails to teach or suggest an account terminal paying a fee from a bank account of one party to a bank account of another party, as claimed.

Regarding Claims 4, 6, 10, 12, 15, and 17, Shear fails to teach or suggest notifying designer terminals if a problem is found in a sample circuit during the design process. In other words, Shear fails to teach or suggest notifying user terminals of problems found in data stored in a database on a remote server. The Examiner refers to col. 7, lns. 20-35 and col. 8, lns. 25-40 as teaching this limitation. (Office Action, p. 3-7). Neither these portions, nor any other portions of Shear describe a problem being found with information stored in a database. Shear also fails to teach or suggest notifying a user terminal of problems found in data stored in a database.

Regarding Claims 5, 6, 11, 12, 16, and 17, Shear fails to teach or suggest conducting circuit design or determining parts to employ through price simulation and noise simulation, as claimed. The Examiner refers to col. 8, lns. 25-40 as teaching this limitation. (Office Action, p. 3-7). This portion of Shear discusses databases of telephone operating companies, and neither this portion, nor any other portion of Shear teaches or suggests conducting circuit design or determining parts to employ through price simulation and noise simulation, as claimed.

Regarding Claims 18-20, 22, 23, and 25-27 Shear fails to teach or suggest a database comprising any of information on an anti-noise circuit, information on parts and vendors that supply the parts, or information on sample circuits, registered by a parts vendor, as claimed. The Examine refers to col. 3, ln. 60 to col. 4, ln. 60 as teaching these claimed limitations. Neither this portion, nor any other portion of Shear teaches or suggests a database comprising the claimed information.

Therefore, Applicants submit that Claims 2-6, 8-12, and 14-27 are patentable at least by virtue of their dependence on Claims 1, 7, and 13 and for the additional reasons presented above.

Applicants respectfully request that the Examiner's §103(a) rejection of Claims 1-27 be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Laura Moskowitz
Registration No. 55,470

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